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EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,173

Applicant(s)

BISSON, BRADY

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Receipt is acknowledged of the election received on 5 October 2004.

The Examiner notes that it appears the claim 22 should be joined to the currently elected claims 3-20, so that claims 3-20 and 22 would be pending. The Examiner has treated claim 22 on the merits, and requests Applicants approval/disapproval of such a change in the pending claims.

Claim Objections - 35 USC § 112

2. Claims 6-7 are objected to under 37 CFR 1.75(c) as being in improper form because they make reference to two sets of claims to different features. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to the Examiner how the authorization code limits use of the reader to authorized distribution programs, as it is unclear what a distribution program is in the context of the claims.

Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 13-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al. (US 6,119,944).

Hudetz et al. teaches readers of potential customers operable with a computer in order to read machine readable medium, where the machine readable medium is a URL encoded barcode/magnetic strip (col 5, lines 27+, col 6, lines 61+, col 10, lines 5+). As these are personal readers, it is understood that they are distributed to customers. Additionally, Hudetz et al. teaches print advertisement in the form of fliers, cards, advertisements, etc. (col 10, lines 5+), interpreted to include cards. Though Hudetz et al. is silent to contracting to have the printing done, it is well known and conventional to do so, to have things printed. Accordingly, the Examiner notes it's well known and conventional to have printed information about a product (interpreted as advertisement, general information, etc.) and that by scanning the stripe/barcode associated with it (see FIG. 1).

Re claim 13, it has been discussed above that the encoded indicia can be in various forms of printed matter, including catalog, page, newspaper, etc. Accordingly, it would have been obvious to distribute it in (paper) card form in an advertising deck (collection of small papers), as an obvious expedient, as an alternative means to distribute advertising, in a smaller/more convenient way, especially as it has been discussed above that the information can be encoded in

cards/fliers, etc. It is obvious that such cards/fliers can be distributed as part of a deck, to facilitate mass distribution of cards.

Re claims 14-16, though Hudetz et al. is silent to distributing/charging for the reader, the Examiner notes that it is well-known and conventional for products to be sold to customers. Additionally, it is conventional for advertisements/fliers to be included in packaged items, especially electronics, in order to provide additional information about related products, or products of the same manufacturer, or additional offers/coupons available, such advertisements being in the form of flyers, cards, etc. As discussed above, it is obvious to include advertisements, coupons, etc. with goods, where such means can provide incentives to purchase the item (knowing that there are additional coupons/savings are inside, for example). Accordingly, the limitations of claims 14-16 can be read as including promotional/advertising/coupons/fliers with the reader, as an incentive to purchase the reader. As it has already been discussed above that such printed media is well known and conventional to be encoded with a URL, such modifications are an obvious expedient to promote purchases of the customer by providing added values/incentives for the purchase.

Re claims 17-18, the Examiner notes that it is well known and conventional for advertisers to pay for advertisement in magazines, catalogs, newspapers, fliers, etc, and that costs can be spread by the advertisers, since advertising space costs money for each advertiser. Accordingly, as discussed above, the use of flyers/cards of the advertisers is an obvious expedient for convenience (reduced size/cost).

Re claim 19, the Examiner notes it's well-known and conventional to update web page information. Accordingly, it would have been obvious to an artisan of ordinary skill in the art to

change information provided at a URL when information needs to be updated, including changing such information after the advertisements have been disseminated.

Re claim 20, though Hudetz et al. is silent to distributing a software program that captures and stores for future retrieval information read with the machine-readable media, the Examiner notes that Hudetz et al. teaches using the machine reader on a personal computer. It is well known and conventional that web pages can be captured and stored for later retrieval on a personal computer. Therefore, including such ability in software for the reader is an obvious expedient to permit storage of data retrieved to be view offline, provided convenience to the user.

Re claim 22, the limitations have been discussed above.

5. Claims 4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al. in view of Sutherland et al. (US 2002/0120757).

Re claims 4, 9, 10, and 11, the teachings of Hudetz et al. have been discussed above.

Hudetz et al. is silent to an authorization code added to the encoded information in order to control access to the URL. The examiner notes that it is well known and conventional for URLs to contain authorization/access codes to control access to the linked URL.

Specifically, Sutherland et al. teaches the URL can contain a time-limited code (paragraph [0014]). Though silent to redirecting the user to an alternate site if the code is not checked/authorized, the Examiner notes that such redirecting, on the Internet, when a URL access code is not validated, is well known and conventional in the art. Re claim 9, it is obvious

to formulate the authorization code with reference to the content of the advertisement in order to direct access to a specific web page, for example.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Hudetz et al. with those of Sutherland et al. to add the authorization code to the URL in order to control access to the information.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al./Sutherland, as applied to claim 4 above, further in view of Russell et al. (US 6,568,595).

The teachings of Hudetz et al./Sutherland et al. have been discussed above.

Hudetz et al./Sutherland et al. is silent to the readers digital logic checking the code.

Russell teaches a reader with an Internet browser (FIG. 3). Accordingly, it would have been obvious to one of ordinary skill in the art that the browser/computer means of the reader would compare authorization codes, as is well known and conventional in the art.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Hudetz et al./Sutherland et al. with those of Russell et al.

One would have been motivated to do this in order to have an reader with a built in browser/computing means, for convenience. Further, the Examiner notes that it would have been obvious to form such an integral structure, since it has been held that forming in one piece an article which has been formerly formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164.

7. Claims 3 and 13-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulla et al. (US 6,119,944).

Mulla et al. teaches readers of potential customers operable with a computer in order to read machine readable medium, where the machine readable medium is a URL encoded barcode (col 8, lines 11+). As these are personal readers, it is understood that they are distributed to customers, since they contain person information (would not be shared with the store).

Additionally, Mulla et al. teaches print advertisement in the form of a catalog with messages in print and a URL-encoded barcode (col 9, lines 8+). Though Mulla et al. is silent to contracting to have the printing done, it is well known and conventional to do so, to have things printed.

Accordingly, the Examiner notes its well known and conventional to have printed information about a product (interpreted as advertisement) and that by scanning the barcode associated with it, additional information is obtained (see Williams US 2003/0111531, paragraph [0006], for example).

Re claim 13, it has been discussed above that the encoded indicia can be in various forms of printed matter, including catalog, page, newspaper, etc. Accordingly, it would have been obvious to distribute it in (paper) card form in an advertising deck (collection of small papers), as an obvious expedient, as an alternative means to distribute advertising, in a smaller/more convenient way. The Examiner interprets cards as small pieces of paper, and interprets deck to include a stack of the individual cards, much like how stacks of small flyers/ads are distributed in packaged electronics, for example. Therefore, simply choosing a different type/size of paper to advertise is an obvious matter of design variation, for reduced costs/convenience (smaller cards/flyers).

Re claims 14-16, though Mulla et al. is silent to distributing/charging for the reader, the Examiner notes that it is well-known and conventional for products to be sold to customers.

Additionally, it is conventional for advertisements to be included in packaged items, especially electronics, in order to provide additional information about related products, or products of the same manufacturer, or additional offers/coupons available. As discussed above, it is obvious to include advertisements, coupons, etc. with goods, where such means can provide incentives to purchase the item (knowing that there are additional coupons/savings are inside, for example). Accordingly, the limitations of claims 14-16 can be read as including promotional/advertising/coupons/flyers with the reader, as an incentive to purchase the reader. As it has already been discussed above that such printed media is well known and conventional to be encoded with a URL, such modifications are an obvious expedient to promote purchases.

Re claims 17-18, the Examiner notes that it is well-known and conventional for advertisers to pay for advertisement in magazines, catalogs, newspapers, etc., as discussed above. Accordingly, as discussed above, the use of flyers/cards of the advertisers is an obvious expedient for convenience (reduced size/cost).

Re claim 19, Mulla teaches the websites/URLs are downloaded to a computer for viewing over the internet. The Examiner notes that it is obvious to change the information provided at the URL after the printed advertisement has been disseminated in order to update the content of the page, as is conventional in the art.

Re claim 20, Mulla et al. teaches that the pen captures and stores information read with the pen/reader (col 4, lines 45+). It is understood that the software/code is included in the reader and therefore is distributed.

Re claim 22, the limitations have been discussed above.

8. Claims 4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulla et al. in view of Sutherland et al. (US 2002/0120757).

Re claims 4, 9, 10, and 11, the teachings of Mulla et al. have been discussed above.

Mulla et al. is silent to an authorization code added to the encoded information in order to control access to the URL. The examiner notes that it is well known and conventional for URLs to contain authorization/access codes to control access to the linked URL.

Specifically, Sutherland et al. teaches the URL can contain a time-limited code (paragraph [0014]). Though silent to redirecting the user to an alternate site if the code is not checked/authorized, the Examiner notes that such redirecting, on the internet, when a URL access code is not validated, is well known and conventional in the art. Re claim 9, it is obvious to formulate the authorization code with reference to the content of the advertisement in order to direct access to a specific web page, for example.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Mulla et al. with those of Sutherland et al. to add the authorization code to the URL in order to control access to the information.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulla et al./Sutherland, as applied to claim 4 above, further in view of Russell et al. (US 6,568,595).

The teachings of Mulla et al./Sutherland et al. have been discussed above.

Mulla et al./Sutherland et al. is silent to the readers digital logic checking the code.

Russell teaches a reader with an internet browser (FIG. 3). Accordingly, it would have been obvious to one of ordinary skill in the art that the browser/computer means of the reader would compare authorization codes, as is well known and conventional in the art.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Mulla et al./Sutherland et al. with those of Russell et al.

One would have been motivated to do this in order to have a reader with a built in browser/computing means, for convenience. Further, the Examiner notes that it would have been obvious to form such an integral structure, since it has been held that forming in one piece an article which has been formerly formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164.

10. Claim 3 and 5-7, 13-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al.

Russell et al. teaches readers of potential customers operable with a computer in order to read machine-readable medium, where the machine-readable medium is a URL encoded magnetic strip (FIG. 6). As these readers are distributed at central locations, (store, mall, etc.), the location can be interpreted as being the customer, or merely the fact that the customer of the store or mall has access to the kiosk as the can be broadly interpreted as distributing to customers. In an alternative embodiment, Russell et al. teaches personal readers (FIG. 1). It is obvious that such readers can be distributed to customers, when the encoded media is a barcode. Though Russell et al. is silent to printing and contracting the printing, the Examiner notes that printing identifying indicia on a magnetic strip card is an obvious expedient, to provide information about the card (an example being printed credit cards, debit cards, gift cards, etc.). Accordingly, the Examiner notes it's well known and conventional to have printed information about a product (interpreted as advertisement, as discussed in the action above) and that by

scanning the barcode associated with it, additional information is obtained (see Williams US 2003/0111531, paragraph [0006], for example).

Re claims 5-7, the Examiner notes that a magnetic strip/reader has been discussed above.

Re claim 13, it has been discussed above that the encoded indicia can be in various forms of printed matter, including catalog, page, newspaper, etc. Accordingly, it would have been obvious to distribute it in (paper) card form in an advertising deck (collection of small papers), as an obvious expedient, as an alternative means to distribute advertising, in a smaller/more convenient way. The Examiner interprets cards as small pieces of paper, and interprets deck to include a stack of the individual cards, much like how stacks of small flyers/ads are distributed in packaged electronics, for example. Therefore, simply choosing a different type/size of paper to advertise is an obvious matter of design variation, for reduced costs/convenience (smaller cards/flyers).

Re claims 14-16, though Russell et al. is silent to distributing/charging for the reader, the Examiner notes that it is well-known and conventional for products to be sold to customers. Additionally, it is conventional for advertisements to be included in packaged items, especially electronics, in order to provide additional information about related products, or products of the same manufacturer, or additional offers/coupons available. As discussed above, it is obvious to include advertisements, coupons, etc. with goods, where such means can provide incentives to purchase the item (knowing that there are additional coupons/savings are inside, for example). Accordingly, the limitations of claims 14-16 can be read as including promotional/advertising/coupons/flyers with the reader, as an incentive to purchase the reader.

As it has already been discussed above that such printed media is well known and conventional to be encoded with a URL, such modifications are an obvious expedient to promote purchases.

Re claims 17-18, the Examiner notes that it is well-known and conventional for advertisers to pay for advertisement in magazines, catalogs, newspapers, etc., as discussed above. Accordingly, as discussed above, the use of flyers/cards of the advertisers is an obvious expedient for convenience (reduced size/cost).

Re claim 19, Russell et al. websites/URLs are viewed by scanning the barcode. The Examiner notes that it is obvious to change the information provided at the URL after the print advertisement has been disseminated in order to update the content of the page, as is conventional in the art.

Re claim 22, the limitations have been discussed above.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. in view of Mulla et al.

The teachings of Russell et al. have been discussed above.

Russell et al. teaches personal scanners (FIG. 1), but is silent to distributing a software program that captures and stores for future retrieval information read.

Mulla et al. teaches that the pen captures and stores information read with the pen/reader (col 4, lines 45+). It is understood that the software/code is included in the reader and therefore is distributed.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Russell et al. with those of Mulla et al.

One would have been motivated to do this in order to access information on the internet by linking the scanner to a computing device.

12. Claims 4 and 9-12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al., further in view of Sutherland et al.

The teachings of Russell et al. have been discussed above.

Russell et al. is silent to authorization codes, and checking of the code to control access.

The Examiner notes the use of authorization codes for URLs to control access is well known and conventional. Specifically, Sutherland et al. teaches the URL can contain a time-limited code (paragraph [0014]). Though silent to redirecting the user to an alternate site if the code is not checked/authorized, the Examiner notes that such redirecting, on the internet, when a URL access code is not validated, is well known and conventional in the art. Re claim 9, it is obvious to formulate the authorization code with reference to the content of the advertisement in order to direct access to a specific web page, for example.

Re claim 12, Russell teaches a reader with an internet browser (FIG. 3). Accordingly, it would have been obvious to one of ordinary skill in the art that the browser/computer means of the reader would compare authorization codes, as is well known and conventional in the art.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Russell et al. with those of Sutherland et al. to add the authorization code to the URL in order to control access to the information.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Parry (US 6,148,331), Yoshino et al. (US 2004/0141485), Miller et al. (US 2002/0065717), Yap et al. (US 2003/0066893), Vasani et al. (US 2004/0006693), and LeRoy et al. (US 5,970,474).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 10/671,173
Art Unit: 2876

Page 15
D. Walsh

A large, stylized handwritten signature in black ink, appearing to read 'D. Walsh'.

DW
12/16/04

A smaller, stylized handwritten signature in black ink, appearing to read 'Thien M. Le'.

THIEN M. LE
PRIMARY EXAMINER